

PATENT

APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF PATENT APPEALS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of)	Examiner: Christopher L. GILLIGAN
Richard C. JOHNSON)	
)	Art Unit: 3626
For: eDROPSHIP: METHODS AND)	
SYSTEMS FOR ANONYMOUS)	Confirmation No.: 7640
eCOMMERCE SHIPMENT)	
)	Customer No.: 53156
Serial No.: 09/490,783)	
)	
Filed: January 24, 2000)	
)	<u>BRIEF IN REPLY TO</u>
Atty. Docket No.: ORCL5628)	<u>EXAMINER'S ANSWER</u>
)	
)	

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief responsive to the Examiner's Answer mailed December 13, 2007.

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A. Arguments

The Office, in the Examiner's Answer, states that

"Furthermore, under the proposed scenario, the carrier would still not have complete knowledge of the transaction." (Page 6 of Examiner's Answer, second full paragraph) and "As described above, the proposed modification does not strip any steps or functions taught by Shub." (Page 6 of Examiner's Answer, end of first full paragraph).

The Office's "proposed scenario," in this case, is that the first and second carriers and the first and second clearinghouses are operated by a same company: "It is old and well known in the art of shipping that shipping companies often employ multiple carriers and clearing houses..." Final Office Action mailed April 6, 2007, paragraph 5. That is, the Office proposes to aggregate Shub et al.'s first, second shippers and the first, second clearing houses into a single entity (a shipper, as urged by the Office and as allegedly taught by Kadaba).

If the first and second clearing houses and the first and second carriers of Shub et al. were to be aggregated into a single entity (i.e., United Parcel Service-UPS-as urged by the Office), then **the shipper would know the merchant** (from whom he shipper picked up the package), **the shipper would know the customer's bank** (from whom the single shipper would receive payment to be transferred to the merchant 103) **and the shipper would know the customer** (to whom the shipper delivers the package). However, such a scheme would be squarely against the explicit teachings of the primary reference to Shub et al., who tell us:

The protocol we describe is such that, except for the customer, no party (employee or company) ever possesses all the information necessary to link the customer to the merchant. The system is also such that some complicity of

Clearly, if Shub et al.'s first shipper, second shipper, first clearinghouse and second clearinghouse were to be aggregated into a single entity, such entity would necessarily possess the information necessary to link the customer to the merchant, **which is expressly forbidden by Shub et al.** Indeed, if such an entity is to deliver the package to the customer, it must: 1) first pick up the package from the merchant; and 2) deliver the package to the customer. To do so, the combined entity must: a) know the identity of the merchant (otherwise, it could not pick up the package from the merchant); and b) know where to deliver the package (otherwise, it would not know where to deliver the package it picked up), thereby linking the customer and the merchant, **which is expressly forbidden by Shub et al.** Indeed, the very indirection introduced by having multiple clearinghouses and multiple shippers is what allows Shub et al. to have packages delivered anonymously and to break the link between the customer and the merchant. Therefore, the Office's "scenario" is contrary to the explicit teachings of Shub et al. and would most certainly constitute a "proposed modification" that would indeed "strip" "steps or functions taught by Shub," contrary to what is asserted in the Examiner's Answer.

Even in the case wherein the shipper is only given the address of the customer (and not the customer's name), to somehow pretend that the customer's identity remains hidden to the shipper is believed to be unrealistic. Indeed, whether the delivery address given to the shipper is that of a detached house or of a multi-family dwelling, the customer's name is most likely on the mailbox or on the customer's other mail. Again, this is why Shub et al. introduced the two shipper and two clearinghouse indirection: to prevent any third party from linking the merchant and the customer.

The Office, in the Examiner's Answer, then challenges Applicant to point to "any portion of Shub that discloses any combination of the clearinghouses and shippers being given the identity of the customer and/or the identity of what was bought in the transaction." (Examiner's Answer, top of page 7).

It is respectfully submitted that the Office now wants it both ways: having urged an interpretation of Shub et al. in which the shippers and clearinghouses are a single entity and after having read the undersigned's arguments that such an interpretation is improper on its face, the Office now requests that the undersigned scour Shub et al. for passages in which "the clearinghouses and shippers being given the identity of the customer and/or the identity of what was bought in the transaction." That is, for purposes of the Final Rejection, the shippers and clearinghouses are a single entity. Thereafter, in an attempt to refute the arguments presented in the Appeal Brief, the Office now requests that Shub et al. be considered as it really is – that is, the first and second clearinghouses and shippers are separate entities.

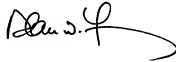
However, to address the Office's request, consider Shub et al., at Col. 5, lines 48-59:

Once the second bank order number x2 has been added to the packages (as shown at block 108), second clearing house 107 transfers them to second carrier 109. The second carrier 109 contacts the payment agency 102 (whose name is part of second bank order number x2), to claim its money and to get the address corresponding to the second bank order number x2. The packages labeled with second bank order number x2 are then transformed into packages with full address(as shown at block 110): In case the customer receiving address is not a personal address(or a business address with a person's name attached), the second bank order number x2 will remain attached to the packages. (Underlining for emphasis)

Therefore, it appears that Shub et al.'s second carrier may be provided with the name of the person to whom to deliver the package, in addition to that person's address, at least in the context of a business address.

The Office's interpretation of the applied combination, as evidenced by the Examiner's Answer, remains untenable. The Board, therefore, is again respectfully requested to reconsider and to reverse the Final Rejection of the claims.

Respectfully submitted,



Date: February 4, 2008

By: _____

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